IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number	:	09/894,476	Confirmation No.:	5938
Applicant	:	Andrew COMAS *et al.*		
Filed	:	June 28, 2001		
Title	:	SYSTEM AND METHOD FOR CHARACTERIZING AND SELECTING TECHNOLOGY TRANSITION OPTIONS		
TC/Art Unit	:	3691		
Examiner:	:	Clement B. GRAHAM		
Docket No.	:	72167.000564		
Customer No.	:	**21967**		

Mail Stop Appeal
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case. No amendments are being filed with this request. Additionally, this request is being filed with a Notice of Appeal. This application is appropriate for a pre-appeal brief conference. A brief history of this application and why Applicants believe that an appeal will succeed are set forth below.

This application was filed on June 28, 2001. The claims were initially rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,812,988 to Sandretto, and then as allegedly anticipated by U.S. Patent No. 6,895,382 to Townsend, and then under 35 U.S.C. § 103(a) as allegedly rendered

obvious by Townsend in view of U.S. Patent No. 6,895,382 to Srinivasan, then by U.S. Patent No. 6,701,514 to Haswell in view of Srinivasan, and finally by U.S. Patent No. 6,610,233 to Underwood in view of Srinivasan. Applicants filed a request for a pre-appeal brief conference, and, as a result, prosecution was reopened. *See* Notice of Panel Decision from Pre-Appeal Brief Review dated January 28, 2010.

After prosecution was reopened, Claims 1-12 were rejected as allegedly anticipated by U.S. Patent No. 7,139,999 to Bowman-Amuah ("Bowman"). Following Applicants' December 15, 2010 response, this rejection was made final.

The Office Action continues to fall short of its obligation to show that all the claimed elements are taught by Bowman. The present invention is directed to the structured development of technology migration options in a legacy enterprise, including hardware and software. Consistent with this, the claims recite the "development of migration options in a legacy transaction enterprise" and "identifying potential components for the legacy enterprise," or similar features.

Bowman, on the other hand, is directed to a "***development architecture framework*** that manages information that supports a project being carried out by a development architecture framework." *See* Bowman, Abstract. That is, Bowman is directed to an integrated development environment architecture that provides a development environment framework and associated guidelines that reduce the effort and costs involved with designing, implementing, and maintaining an integrated development environment. Furthermore, Bowman discloses that the purpose of the development environment is to support the tasks involved in the analysis, design, construction, and maintenance of business systems, as well as the associated management processes. *Id.*, column 9, lines 53-56. To the extent that Bowman discloses legacy systems, it does not disclose the migration of those systems. Rather, it discloses the use of extraction tools to extract ***data*** from the

legacy system, and a restructuring tools to rebuild the legacy systems, not the migration of these systems. *Id.*, col. 95, ll. 2-8, 30-37.

In sharp contrast, the present claims are directed to migrating the components of a legacy transactional enterprise themselves. Simply stated, Bowman is directed to developing new components for a system, whereas the present claims are directed to identifying what components of a legacy transaction enterprise should be migrated.

In the first Office Action following the reopening of prosecution, the Examiner alleged that Bowman anticipated the pending claims because it disclosed all claim elements. *See* Office Action mailed October 4, 2010 at 4. Applicants responded by arguing that Bowman did not disclose at least "developing risk factors for the components of the legacy enterprise," "identifying unmet opportunities" and "developing risk factors for the unmet opportunities." The Examiner responded, alleging for the first time that these elements are ***inherent***. Applicants respectfully disagree.

According to the MPEP, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is ***necessarily present*** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. ***The mere fact that a certain thing may result from a given set of circumstances is not sufficient.***'" MPEP 2112 (quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted)) (emphasis added). Further, "[i]n relying upon the theory of inherency, the examiner ***must provide a basis in fact and/or technical reasoning*** to reasonably support the determination that the allegedly inherent characteristic ***necessarily flows*** from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter.

1990) (emphasis added). The Office Action has not provided the requisite reasoning.

The Examiner's "reasoning" -- explained for the first time in the Office Action -- is fraught with assumptions that are not present in Bowman:

> Bowman-Amuah discloses an ***integrated development architecture framework in a legacy system***, that consist of software and hardware migration, and ***upgrades to application software and systems software*** which would have been inherently consistent with migration options ***because a feasibility study would have to be done prior to the migration*** in order to determine which software or hardware options would be chosen that is most economical and feasible or compatible with the legacy system and ***identifying potential components, developing risk factors, for the components and identifying unmet opportunities would have had to be done as part of the feasibility study*** whereby upon migration all the required components would be in place. Therefore it is inherent that Applicants claimed limitations of software or hardware migration were addressed with the teachings of Bowman-Amuah.

Office Action, page 7. As noted above, it is simply incorrect to state that Bowman discloses "an integrated development architecture framework in a ***legacy system***." Simply put, Bowman has nothing to do with ***migration*** of software and systems in a legacy enterprise. As such, it is silent with regard to any "upgrades to application software and system software" or any "feasibility study" associated with the migration of legacy software and systems. These "features," which are alleged to form the basis for the inherency argument, simply are not disclosed or suggested in Bowman. Indeed, the very fact that this sort of hindsight-based reasoning is alleged is evidence that Bowman does not disclose each and every element of the pending claims, as required by 35 U.S.C. § 102.

In view of the foregoing, an appeal on that basis will likely succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by Applicants when the grounds is so clearly improper.

Respectfully submitted,

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Date: November 18, 2011 By: _____

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